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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,304	08/18/2003	Zoran Nesic	10268.202	2007
7590 08/23/2004				
PATTON BOGGS LLP 2550 M Street, NW Washington, DC 20037-1350			EXAMINER LE, DANG D	
			ART UNIT 2834	PAPER NUMBER

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/642,304	NESIC, ZORAN	
	Examiner	Art Unit	
	Dang D Le	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear if "an actuator motor" at line 8 is the actuator motor at lines 2-3. It is neither clear if "said housing" at line 9 refers to "a frame" at line 2.

Regarding claim 3, it is not clear if "a control circuit" at line 2 is a different one from the control circuit recited in claim 1. Are there two control circuits?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lekeux et al. (6,191,512).

Regarding claims 1-13, Lekeux et al. shows all of the limitations of the claimed invention.

6. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Haag et al. (6,232,684).

Regarding claim 1, Haag et al. shows an integral actuator (20), comprising:

- A frame (22) constructed and arranged for securing an actuator motor (34) having an output shaft (40), having a first at least partially closed chamber (30) for receiving said output shaft, a bearing support for supporting a driven member (36), and at least a partially enclosed second chamber (where 84 located), and a passage (28) connecting said first chamber with said second chamber;

- An actuator motor (34) with a power output shaft (40), secured to said housing such that said power output shaft extends into said first chamber (30);
- A control circuit (84) mounted in said second chamber, said control circuit having circuitry for selectively transferring an externally supplied electrical power, through said passage, to said actuator motor; and
- A power translation member (38) connected to said output shaft.

Regarding claims 2-5 and 7, it is noted that Haag et al. also shows all of the limitations of the claimed invention.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto et al. (6,452,297).

Regarding claim 1, Yamamoto et al. shows an integral actuator (1), comprising:

- A frame (3) constructed and arranged for securing an actuator motor (2) having an output shaft, having a first at least partially closed chamber (where 22 located) for receiving said output shaft, a bearing support (33) for supporting a driven member (28), and at least a partially enclosed second chamber (where 41b located), and a passage (from 42 to bearing 25) connecting said first chamber with said second chamber;
- An actuator motor (2) with a power output shaft, secured to said housing such that said power output shaft extends into said first chamber;

- A control circuit (41b) mounted in said second chamber, said control circuit having circuitry for selectively transferring an externally supplied electrical power, through said passage, to said actuator motor; and
- A power translation member (28) connected to said output shaft.

Regarding claims 2-5 and 7, it is noted that Yamamoto et al. also shows all of the limitations of the claimed invention.

Information on How to Contact USPTO

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dang D Le whose telephone number is (571) 272-2027. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on (571) 272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/20/04

DANGLE
PRIMARY EXAMINER

